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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,133	06/11/2001	Janice Au-Young	PF-0589 USN	5220

7590

10/02/2003

Incyte Genomics Inc
3160 Porter Drive
Palo Alto, CA 94304

EXAMINER

BASI, NIRMAL SINGH

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 10/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,133

Applicant(s)

AU-YOUNG ET AL.

Examiner

Prema M Mertz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restriction

1. This application is a 371 of PCT/US99/20468. For applications filed under 371, PCT rules for lack of unity apply.

2. Restriction is required under 35 U.S.C. 121 and 372.

This application contains inventions or groups of inventions which are not so linked as to form a single inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Groups 1-16. Claims 1-2 and 15, drawn to a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:1, SEQ ID NO:2, SEQ ID NO:3, SEQ ID NO:4, SEQ ID NO:5, SEQ ID NO:6, SEQ ID NO:7, SEQ ID NO:8, SEQ ID NO:9, SEQ ID NO:10, SEQ ID NO:11, SEQ ID NO:12, SEQ ID NO:13, SEQ ID NO:16, SEQ ID NO:17, SEQ ID NO:18.

Groups 17-32. Claims 3-4, 9-14, drawn to a polynucleotide encoding a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:1-13, SEQ ID NO:16-18, vector, host cell and method of producing the polypeptide of SEQ ID NO:1-13, SEQ ID NO:16-18.

Groups 33-48. Claims 7-8, drawn to a method for detecting a polynucleotide encoding a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:1-13, SEQ ID NO:16-18.

Groups 49-64. Claim 16, drawn to an antibody to a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:1-13, SEQ ID NO:16-18.

Groups 65-80. Claim 17, drawn to an agonist to a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:1-13, SEQ ID NO:16-18.

Groups 81-96. Claim 17, drawn to an antagonist to a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:1-13, SEQ ID NO:16-18.

Group 97-112. Claim 19, drawn to a method of treating or preventing a disorder by administering a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:1-13, SEQ ID NO:16-18.

Group 113-128. Claim 20, drawn to a method of treating or preventing a disorder by administering an antagonist to a polypeptide comprising the amino acid sequence set forth in SEQ ID NO:1-13, SEQ ID NO:16-18.

Should any one of the Groups from 1-128 be elected, Applicant is required to select one polypeptide (one amino acid sequence) directed to the claimed invention, for examination on the merits. Any change of amino acid residues at any one or more positions in the polypeptide sequence is considered, absent factual data to the contrary, a distinct polypeptide. Once one polypeptide sequence is selected, all other sequences will be withdrawn from consideration.

The inventions listed as Groups 1-128 do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2 they lack the same or corresponding special technical feature for the following reasons:

The PCT rules define a special technical feature as a feature, which defines a contribution over the prior art. The first claimed invention fails to recite such a feature, since a single amino acid found in the prior art encompasses a fragment of the polypeptide set forth in Group 1. Since the first claimed invention lacks a special technical feature, the other claimed inventions cannot share a special technical feature with the first claimed invention. The inventions of Groups 1-16 are patentably distinct from the products of Groups 17-32 because the product of Groups 1-16

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can be made by a materially different method other than recombinant protein expression i.e. the proteins can be isolated from nature using various purification procedures. The inventions of Groups 1-16 are patentably distinct from the products of Groups 65-96 because the products of Groups 65-96 can be used in methods that are materially different from the therapy of Groups 97-112, such as in the generation of antibodies. The inventions of Groups 17-32 are patentably distinct from the products of Groups 65-96 because the products of Groups 65-96 can be used in methods that are materially different from the hybridization method of Groups 33-48, such as in the generation of antibodies. The methods of Groups 97-112 and 113-128 are patentably distinct because each recites method steps not required by the other, and the search of the disparate methods in one patent application would result in an undue search burden.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Advisory Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prema Mertz whose telephone number is (703) 308-4229. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached on (703) 308-6564.


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Official papers filed by fax should be directed to (703) 305-3014 or (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 746-5300.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [yvonne.eyler@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.


Prema Mertz Ph.D.
Primary Examiner
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September 30, 2003